

### **REMARKS/ARGUMENTS**

In the Office Action mailed October 17, 2007, claims 27-36 and 45-49 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the claims presented herein are believed to be patentable over the cited references.

Claims 27, 28, 30, 32, 34, 47 and 48 have been amended. No claims have been added. Claims 29, 31 and 37-46 are cancelled. As such, claims 27, 28, 30, 32-36 and 47-49 remain pending, and are presented for reconsideration and examination.

### **ELECTION/RESTRICTIONS**

Applicants hereby cancel claims 37-44 of the nonelected species to complete Applicants' reply to the Response to Election Requirement filed September 19, 2007.

### **SPECIFICATION**

Per the Examiner's request, Applicants have amended the history of the continuations and continuations-in-part for this application as set forth in the replacement paragraph provided.

### **DOUBLE PATENTING**

The Examiner rejected claim 48 under 35 U.S.C. §101 as claiming the same invention as that of parts a, b, and c of claim 1 in U.S. Patent 6,254,535. Citing *In re Goodman*, 11 F.3d 1046

(Fed. Cir. 1993), the Examiner explained that a non-statutory double patenting rejection applied to reject the alleged “genus” claim 48 of the present application where the “species” claim 1 of U.S. Patent 6,254,535 was previously patented. The Applicants respectfully submit that *Goodman* was erroneously applied to claim 48 since said case is directed to obviousness-type double-patenting, which can be overcome with a terminal disclaimer. Non-statutory obviousness-type double patenting does not apply under the statutory provisions of 35 U.S.C. § 101.

In any case, claim 48 has been amended to add additional limitations which Applicants believe more specifically claim Applicants’ invention. As such, any obviousness-type double patenting rejection should not apply.

In light of the foregoing arguments, withdrawal of the rejection of claim 48 under 35 U.S.C. § 101 in view of claim 1 of U.S. Patent 6,254,535 is respectfully requested.

#### **CLAIM REJECTIONS – 35 U.S.C. § 102(b)**

The Examiner rejected claims 27-33 and 48 under 35 U.S.C. § 102(b) as being anticipated over United States Patent No. 3, 240,516 to Barish *et al.* (hereinafter referred to as “Barish”). In light of the following remarks, Applicants respectfully submit that these claims are allowable.

Initially, Applicants note that it is axiomatic that to qualify as an anticipation under Section 102, the cited reference must “bear within its four corners adequate directions for the practice of the patent invalidated.” (See, for example, Dewey & Almay Chemical Co. v. Mimex Co., Inc., 52 U.S.P.Q. 138 (2<sup>nd</sup> Cir. 1942)). In the Office Action, the Examiner states that the reference discloses “a joint structure of the retractor comprising: a bifurcated member 22 having

two elongated prongs 24; an elongated handle segment 10; and ball joint 14 providing means for rotatably and pivotally connecting the handle segment 10 to the bifurcated member 24, allowing the bifurcated member to rotate and pivot relative to the handle segment." See Office Action, page 3, paragraph 6. To support the rejection, the Examiner cites figures 1 and 2 and column 2, lines 34-37 of Barish.

Barish relates to a clamp structure for use in a surgical procedure where it is necessary to hold a portion of a patient's body in an exact position. The inventive feature of the Barish reference is the provision of a joint structure handling multiple independent joints "wherein all of the joints are locked or unlocked by a single movement at one of the center joints." Col. 1, lines 12-14. The movement of the Barish joints within the clamp structure refutes any anticipation by this reference over the applicants' invention as claimed. An analysis of the lower joint structure 14 of Barish highlights the features that distinguish this reference from the applicants' invention. With reference to figure 2 of Barish, which is an enlarged view of the lower joint structure 14 illustrated in figure 1, the lower joint structure 14 comprises an arm 10 having an enlarged end 73 that is threadably engaged to a ball retainer 68. Within the arm 10 is a rod 40 that moves up and down as the center joint structure 18 is locked and unlocked.

In contrast, the applicant's invention, as recited in claims 27 and 48, discloses a shaft within a bore of a handle segment of the stabilizer in which the bore and shaft are engaged so that the movement of the shaft is controlled by the interface between the shaft and the bore as the shaft is moved within the bore. This interface is specifically claimed as threading in claim 48. The threaded means of Barish connects the arm 10 to the ball retainer 68 and does not affect the

movement of the rod 40 within the arm 10. The sole mechanism of control of the movement of the rod 40 is the locking of the center joint structure 18.

As such, Applicants believe that amended claims 27 and 48 are patentable over Barish and respectfully requests that the rejection to said claims be withdrawn.

Dependent claims 28, 30, 32, and 33 also stand rejected under 35 U.S.C. § 102(b) as unpatentable over Barish. However all of said dependent claims depend directly or indirectly from one or another of base independent claim 27. As discussed above, because Barish fails to disclose each and every claim limitation recited by base independent 27, said references also fail to teach or disclose the very same claim limitations in each of the dependent claims. These dependent claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed by the art of record. The dependent claims are therefore believed patentable.

Therefore, for all of the reasons discussed above, claims 27, 28, 30, 32-33, and 48, as amended, are not anticipated under 35 U.S.C. § 102(b) in view of Barish. Applicants respectfully request that the rejection with regard to said claims be withdrawn.

#### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

The Examiner rejected claims 34-36, 47 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Barish in view of U.S. Patent No. 2,674,501 to Biegler (hereinafter referred to as “Biegler”).

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. The Examiner has asserted that Barish discloses all of the

limitations of the rejected claims except for a means for removably mounting of the bifurcated member 24 to the handle 10. To supply the missing limitations, the Examiner proffers Biegler for its disclosure of a handle connection for garden hoes. The Examiner has impermissibly applied hindsight reconstruction to create the rejection of these claims as it is inconceivable that one of ordinary skill in the art of applying means for stabilization of a predetermined area of the patient's body during surgical intervention would look to the non-analogous art of garden tools for a teaching, suggestion, or motivation to invent the subject matter as claimed.

Moreover, Applicants' invention, as recited in amended independent claims 27 and 48 and the depending claims stemming therefrom provides for a different structure from Barish and a different configuration of the locking mechanism than that provided by Biegler. Barish does not meet all of the claim limitation of base claims 27 and 48, as amended. Biegler does not supply the "longitudinally-extending bore", "shaft", and "socket" of amended base claim 27 "wherein a portion of said bore complementarily engages a portion of said shaft so that the interface therebetween controls the relative movement between said shaft and said bore as said shaft is moved within said bore." Biegler also does not supply the claim limitations of amended base claim 48 missing in Barish "wherein a portion of said bore complementarily engages a portion of said shaft so that the interface therebetween controls the relative movement between said shaft and said bore as said shaft is moved within said bore." As such, Biegler does not supply the limitations missing from Barish.

Additionally, Biegler teaches away from Applicant's invention. Biegler provides its locking mechanism solely within a notched interface between the Biegler handle socket and the indented surface of the Biegler blade. In contrast, Applicant's invention discloses that the

locking mechanism is engaged by the joint interaction threaded engagement of the bore and shaft within the handle and the resultant frictional grasping of the ball of the bifurcated member's connection to the handle socket. In column 2, lines 29-33, Biegler provides "a connector unit adapted to be mounted on the upper edge of [a] stated blade, said connector unit... provided... with a row of aligned recesses circumferentially spaced and providing selectable usable keeper seats." Bieger further discloses "a ball and socket joint, there being three prongs and the latter being arranged that two of them are diametrically opposite...and the remaining prong being located midway...and provided on its interior surface with an integral locking detent." See column 2, lines 38-44. The locking detent is "selectably engageable with said keeper seats in order that the socket unit and connector unit may be releasably coupled and thus joined together in predetermined positions. See column 2, lines 45-49.

Biegler confines its locking mechanism to the engagement of "useable keeper seats" on the connector unit and "detents" on the ball and socket joint. These male and female interconnecting parts are completely different from the locking mechanism of Applicant's invention and teaches away from the frictional locking engagement of the invention disclosed in the rejected claims. As such, Applicant respectfully asserts that: (a) Biegler does not teach all of the limitations of amended base claims 27 and 48, (b) one of ordinary skill in the art would not have considered Biegler to make an obvious combination with Barish to arrive at Applicant's invention, as recited in dependent claims 34-36, 47 and 49, and (c) that the combination of Barish and Biegler would not have predictably resulted in the invention set forth in Applicant's claims.

As such, Applicant believes that the dependent claims 34-36, 47, and 49, as amended, are also patentable over Barish in view of Biegler and respectfully requests that the rejection to said claim be withdrawn. All of said dependent claims depend directly or indirectly from one or another of base independent claims 27 or 48. As discussed above, because Barish and Biegler, taken alone or in combination, fail to teach or disclose every claim limitation recited by one or another of base independent claims 27 or 48, said references also fail to teach or disclose the very same claim limitations in each of the dependent claims. These dependent claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

Therefore, for all of the reasons discussed above, claims 34-36, 47, and 49, as amended, are not obvious under 35 U.S.C. § 103 in view of Barish and Biegler. Applicant respectfully requests that the rejection with regard to said claims be withdrawn.

The Examiner has also rejected claims 45-46 under 35 U.S.C. § 103(a) as being unpatentable over Barish in view of U.S. Patent No. 5,133,724 to Wilson (hereinafter referred to as "Wilson"). For reasons unrelated to patentability, the applicants hereby submit the enclosed amendment to the claims, which list the cancellation of claim 45 and 46.

### **CONCLUSION**


In view of the foregoing remarks, Applicants respectfully request all the objections and rejections to the specification and claims be removed. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1797 in an effort to resolve any matter still

outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 059742.022104.

Respectfully submitted,

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